



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,784	05/01/2001	Rolf Lakomy	2345/153	3669
26646	7590	03/21/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			MILEF, ELDA G	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/830,784	LAKOMY ET AL.	
	Examiner	Art Unit	
	Elda Milef	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/01/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3628

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. PCT EP/00/08263, filed 8/24/2000. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must

Art Unit: 3628

be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Art Unit: 3628

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, claims 5-14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

Art Unit: 3628

include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3628

Claims 8, 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 13 recite the limitation "the digital broadcasting network" (p. 32, line 6 and p.4, line 12 respectively). There is insufficient antecedent basis for this limitation in the claim.

Claims 10-14 recite "an arrangement" (p. 3, line 12 and p.4, lines 1, 3, 7, 14 respectively. It is unclear to the Examiner if these are method or apparatus claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3628

Claims 5-7, 9-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mean (Meandzija, US Patent No. 6,170,005) in view of Chaney (WO 96/07267)

Re claim 5: Mean discloses:

controlling a right-of-access by a customer through a service center, in response to a request from the service provider to the service center, using the specifically assigned EMM clearing signal by performing:

(ii.) a direct clearing operation by sending the specifically assigned EMM clearing signal from the service center, with an assistance of a data transmission service in a digital broadcasting service, to the security module to clear the customer.

("The method allows a management entity component, such as a computer workstation operated at a control center, to coordinate the actions of different agent components, such as hardware used at the headend or uplink site of a television network. In particular, the agent components may be hardware (e.g., including firmware and software) used to provide conditional access to a television signal.")-see col. 2 lines 44-51 and ("the output mux 280 may be an MPEG transport stream which includes various other types of data...The output of the

Art Unit: 3628

scrambler 285 comprises CA data that is subsequently transmitted to an end user, e.g., via CATV network or digital satellite broadcast network. The synchronizer 270 times the multiplexing of the private data from component 230, EMMs from component 240, ECMS from component 220, and control words from component 275..."-see col. 15 line 64-col. 16 line 25, also see cols.3-4;

Although Mean discloses conditional access -see cols. 1-4, and EMMs appended to various programming services to authorize the decoders to receive particular programming services-see col. 15 lines 46-53, Mean does not explicitly disclose the assignment of the EMM clearing signal to the security module (smart card). Chaney however, teaches ("Entitlement management involves modifying information stored in the card that specifies the card owner's entitlements ...The processor adds and deletes entitlements in response to entitlement information in entitlement management messages (EMM) that are included in the input signal..."-see p. 2 lines 11-21, pp. 5-6. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mean to include adding/deleting entitlements via EMMs that are included in the input signal and stored in a "smart card" as was taught by Chaney in order to store information relating to the limited access to programs on pay-TV systems.

Art Unit: 3628

Re claim 6: Mean does not disclose:

wherein an electronically stored, service-specific credit balance is allocatable in monetary units to the security module.

Chaney however teaches ("A card is issued to a user with initial entitlement information stored...Entitlement information may include data identifying the user and data specifying the scope of initial access entitlement (e.g., duration and/or specific programs the user has paid for)...EMM includes information indicating subscription (long term access) and pay-per-view (single program access) services that the user has paid for.")-see p. 5 line 29- p. 6 line 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mean to include storing data on the smart card relating to programs that have been paid for by the user in order to determine if the user paid for a service and therefore has access to that service.

Re claim 7: Mean discloses:

wherein in the indirect clearing operation of the security module of a querying customer, the data transmission service is provided by one of a fixed-line modem, a Global System for

Art Unit: 3628

Mobile Communications (GSM) modem and a GSM-service Management System (GSM-SMS) modem. -see ("modem")-col. 16 lines 47-56.

Re claim 9: Mean discloses:

wherein the chargeable service includes at least one of a pay TV service, a digital radio broadcasting service, a digital video broadcasting service, a service of a Society for Worldwide Interbank Financial Telecommunications and a video-on-demand service. -see col. 2 lines 52-55, col.4 lines 11-14.

Re claims 10-12, 14: The Examiner in interpreting "arrangement" to mean --apparatus--. Further an apparatus would have been necessary to perform the method of previously rejected claims 5-7, 9 and are therefore rejected using the same art and rationale.

5. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mean in view of Chaney as in claim 5 above and further in view of Hayes (US Patent No. 6,295,448)

Re claim 8: Mean and Chaney do not specifically disclose an approximate location of the querying customer is found with the assistance of at least one of a digital cellular network and

Art Unit: 3628

a mobile telephony network. Hayes however, teaches ("In this embodiment of the present invention, the communication path and the communication format are initially assigned to the mobile telephone(s) 100 and the device(s) 110 either by preprogramming according to the fixed assignment described in FIG. 1 and FIG. 2 or by assignment from the mobile telephone system 120...The selection can be based on any criteria including, but not limited to, the time of day, day of the week or geographic location of the mobile telephone(s) or other device(s)..."). -see col. 9 line 62-col. 10 line 11. Also, see col. 8 lines 24-52, cols. 2,5, FIGs. 2-8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mean and Chaney to include determining the geographic location of the mobile telephone as was taught by Hayes in order to effectuate unidirectional and bidirectional communication directly between a mobile telephone and another device such as entertainment equipment interfaces.

Mean discloses the specifically assigned EMM clearing signal for clearing the querying customer is only routed into the digital broadcasting network ("At least one of the first and second agent components may be a conditional access agent component for inserting conditional access data, such as EMMs

Art Unit: 3628

and ECMs, into the digital broadcast stream.")-see col. 4 lines 11-14, and col. 2 line 65-col.3 line 2.

Mean and Chaney do not specifically disclose in which the querying customer is situated at a time of a call and ordering of the specifically assigned EMM clearing signal. Hayes discloses the identification of the cellular phone location and time of day as shown above, and Hayes discloses determining a communication path and communication format to be assigned to the mobile telephone and the device. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to specifically assign an EMM clearing signal as shown by Mean to the communication path and format to be assigned as shown by Hayes in order to initiate communication directly between the mobile telephone and the other device.

Re claim 13: The Examiner in interpreting "arrangement" to mean --apparatus--. Further an apparatus would have been necessary to perform the method of previously rejected claim 8 and is therefore rejected using the same art and rationale.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3628

US Patent No. 5,990,927 (Hendricks et al.)-Cited for its reference to a television program signal arriving at the subscriber's home through cellular telephone connections, and for the use of a turbo card which provides a method for a remote location to receive information on programs watched and control the operation of the set top converter.

US Patent No. 6,459,427 (Mao et al.)-Cited for an apparatus and method for webcasting over digital broadcast TV network.

US Patent No. 6,002,394 (Schein et al.)-Cited for systems and methods for linking television viewers with advertisers and broadcasters.

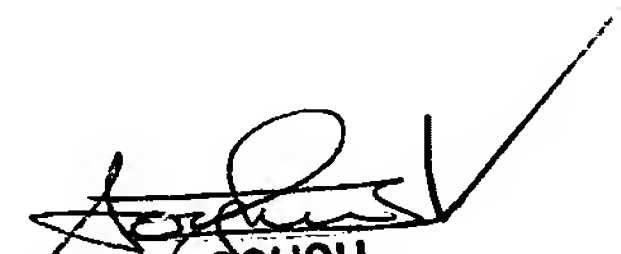
US Patent No. 6,971,008 (Wasilewski et al.)-Cited for its reference to authorization of series and conditional access system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600